REMARKS

By this amendment, Applicant adds new claims 34-36 to claim subject matter to which the inventor is entitled to. Claims 20-27, 30, 31, and 33-36 are currently pending.

In the Office Action,[1] the Examiner indicated that the information disclosure statement failed to comply with 37 CFR 1.98(a)(3); rejected claims 20, 24, 30, and 33 under 35 U.S.C. § 103(a) as being unpatentable over P. Stockl, GSM/DCS Coverage Measurement Systems (hereinafter Stockl) in view of U.S. Patent No. 5,602,831 to Gaskill; rejected claims 22-23 under 35 U.S.C. § 103(a) as being unpatentable over Stockl in view of Gaskill and further in view of U.S. Patent No. 5,960,341 to LeBlanc et al. (hereinafter LeBlanc); previously rejected claims 20, 23, and 27 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 10, 16, and 17 of co-pending Application No. 09/929,034 in view of Stockl; and objected to claims 21, 25, 26, and 31 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant acknowledges, with appreciation, the Examiner's indication of allowable subject matter and submits that this Amendment places the application, *prima facie*, in condition for allowance, as discussed below.

The Examiner indicates that the reference DE4428729 has not been considered since, according to the Examiner, the information disclosure statement filed June 24,

[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

2005 failed to provide a concise statement of the "relevance for DE 4428729 A1 (even if it is referred to in the Search report)." (Office Action, p. 2). Applicant respectfully submits to the Examiner that in the case of a foreign language document cited in a search report, the search report may be used in lieu of a statement of relevance. Specifically, M.P.E.P. 609.04(a)(III) states the following:

> Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, **the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report** or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, **or merely an "X", "Y", or "A" indication on a search report**.

M.P.E.P. 609.04(a)(III) (emphasis added). Applicant further submits to the Examiner that DE 4428729 A1 was considered by an examiner in U.S. Application No. 09/929,034 (now U.S. Patent No. 6,959,189), which is a parent case to this divisional application. As such, M.P.E.P.609.02 states that the "examiner will consider information which has been considered by the Office in a parent application when examining . . . (B) a divisional application filed under 37 CFR 1.53(b)[.] Applicant thus requests that the Examiner consider DE4428729 and initial the PTO/SB/08 filed with the Information Disclosure Statement of June 24, 2005. For the Examiner's convenience, Applicant includes additional copies of the DE 4428729 A1 and a corresponding European search report.

The Examiner rejected claims 20, 24, 30, and 33 under 35 U.S.C. § 103(a) as being unpatentable over Stockl in view of Gaskill. Applicant traverses this rejection.

Claim 20 defines a method for determining for a wireless device a signal coverage along a route. Claim 20 recites a combination including, inter alia, "determining one or more local means based on the received signal strength information and a speed of a receiver of the received signal strength information."

In contrast to claim 20, Stockl statistically evaluates signal coverage measurements by "averaging over user-defined intervals." (Stockl, p. 324, right column). Because Stockl teaches an approach based on "user-defined intervals" rather than the speed of a receiver, Stockl fails to disclose at least the claim 20 step of "determining one or more local means based on the received signal strength information and a speed of a receiver of the received signal strength information." The Examiner does not even allege that Stockl discloses this step. (Office Action , page 4). Instead, the Examiner relies on Gaskill to fill the gap in Stockl's disclosure.

Although Gaskill teaches varying packet size according to the speed of the receiver (Gaskill, col. 3, ll. 64-67), varying packet size based on speed does not constitute the claim 20 step of "determining one or more local means based on the received signal strength information and a speed of a receiver of the received signal strength information." Indeed, nowhere does Gaskill disclose or suggest this step. Because neither Stockl nor Gaskill, whether taken alone or in combination, discloses or suggests the "determining step, the rejection of claim 20 under 35 U.S.C. § 103(a) should be withdrawn.

Applicant further submits that a prima face case of obviousness has not been made by the Examiner. To establish a prima face case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references,

taken alone or combined, must teach or suggest each and every element recited in the claims. (See M.P.E.P. §2143.03 (8th ed. 2001)). As noted above, Stockl and Gaskill, whether taken alone or in combination, fail to teach or suggest at least one of the elements of claim 20. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist that the proposed modification will work for the intended purpose. Moreover, each of the there requirements must be found in the prior art, and not be based on Applicant's disclosure. (See M.P.E.P. § 2143 (8th ed. 2001)).

Concerning the motivation to combine, the Examiner uses Gaskill to attempt to fill the gaps in Stockl's disclosure. In that regard, the Examiner alleges that Gaskill teaches optimizing packet size to eliminate the effects of poor reception according to the speed of motion of the receiver. The Examiner then alleges that one of ordinary skill in the art would have understood that the speed of the receiver could be used to optimize RF transmission based on current and projected locations. Lastly, the Examiner alleges that it would have been obvious to modify Stockl "such that the speed of the receiver is determined, to provide means for including the receiver's speed of motion to optimize RF communications and also understand where the user is and how fast they are moving." (Office Action, p. 4). Applicant submits that the Examiner has either used impermissible hindsight or has taken Official Notice with regard to the modifications to Stockl and Gaskill proposed by the Examiner. If the Examiner is using impermissible hindsight, Applicant submits that any motivation to combine must be

found in the prior art itself, and not be based on Applicant's disclosure—otherwise, the Examiner's position should be withdrawn. (See M.P.E.P. § 2143 (8th ed. 2001)). If the Examiner has taken Office Notice, Applicant submits that the Examiner must provide a reference or affidavit to support such a position or withdraw the position. (See M.P.E.P. § 2144.03).

Moreover, concerning the modification of Stockl and Gaskill as proposed by the Examiner, Applicant submits that optimizing RF transmission based on current and projected location does not constitute any element of claim 20. Nowhere does claim 20 require optimizing RF transmission. Applicant thus submits there is no relevance between Gaskill's purported RF optimization and the elements of claim 20. Accordingly, Gaskill contains no motivation to combine.

Concerning the expectation of success, even if such a modification to Gaskill and Stockl were possible, there is no suggestion or teaching in either reference on how to make such a modification or whether the modification would be successful. Indeed, Stockl discloses a signal coverage measurement system, while Gaskill discloses a very different type of system for optimizing packet size. Applicant thus submits that the Examiner's proposed modifications to those two very different references are impractical, if not impossible. Therefore, absent a prima facie showing by the Examiner, the rejection of claim 20 should be withdrawn for this additional reason.

Claim 24 depends from independent claim 20. Claims 30 and 33, although of different scope, includes recitations similar to those of claim 20. For at least the reasons given above with respect to claim 20, claims 24, 30, and 33, are thus allowable

over Stockl and Gaskill, whether taken alone or in combination, and thus the rejection of those claims under 35 U.S.C. § 103(a) should be withdrawn.

The Examiner rejected claims 22 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Stockl in view of Gaskill and further in view LeBlanc. Applicant traverses this rejection.

Claims 22 and 23 depend from claim 20 and include all the steps and recitations therein including, inter alia, "determining one or more local means based on the received signal strength information and a speed of a receiver of the received signal strength information." For at least the reasons given above, neither Stockl nor Gaskill discloses or suggests at least this step. Although LeBlanc discloses a positioning system, LeBlanc fails to disclose the claimed step. Indeed, the Examiner does not allege that LeBlanc discloses or suggests this step. Even if Stockl, Gaskill, and LeBlanc were modifiable in the manner proposed by the Examiner at page 5 of the Office Action (and Applicant does not agree that they are modifiable), the Examiner's modifications to Stockl, Gaskill, and LeBlanc fail to cure their noted deficiencies. Claims 22 and 23 are thus allowable over Stockl, Gaskill, and LeBlanc, whether taken alone or in combination, and the rejection of claims 22 and 23 under 35 U.S.C. § 103(a) should be withdrawn.

The Examiner rejected claims 20, 23, and 27 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 10, 16, and 17 of co-pending Application No. 09/929,034 in view of Stockl.

Although disagreeing with the double-patenting rejections, in an effort to advance prosecution, Applicant files concurrently herewith a Terminal Disclaimer[2] concurrently with this paper, obviating the obviousness-type double patenting rejections.

New claims 32-36 are allowable over the references cited by the Examiner for at least the reasons given above.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: December 21, 2005

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[2] Applicant points out that: "[t]he filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection." M.P.E.P. § 804.02(II), 8th Ed., Aug. 2001, p. 800-32 (citing *Quad Environmental Tech. Corp. v. Union Sanitary Dist.*, 946 F.2d 870 (Fed. Cir. 1991)). As M.P.E.P. § 804.02(II) indicates, "[t]he Court indicated that the 'filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection.'" *Id.*